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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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08/926,872

09/10/1997

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SLD2121

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10/28/2003

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EXAMINER

GORDON, RAEANN

ART UNIT

PAPER NUMBER

3711

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 39

Application Number: 08/926,872
Filing Date: September 10, 1997
Appellant(s): SULLIVAN ET AL.

Richard Klein
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8-15-03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: whether or not the issue regarding the 35 USC 102(b) rejection over Higuchi is proper.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1 and 3-8 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

EP 633043A

HIGUCHI

1-1995

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 and 3-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 - the core with a specific gravity less than 1.4 is non-enabling. Applicant discloses a specific gravity of 1.47 and 1.17, one of which is over the 1.4 limitation. The remaining values in the range are non-enabling subject matter. The limitation requires the specific gravity to be less than 1.4 or from 0 to 1.4. The specific gravity of the intermediate layer is not enabling. The claim requires the intermediate layer to be less than 1.2. Applicant discloses values of 1.3, 0.95, 0.953, and 0.960 for the specific gravity being less than 1.2. Obviously 1.3 is outside the range in question. The values 0.953 and 0.960 cited on page 24 of the specification are specific gravity values for the base ionomer and not the actual composition of the intermediate layer. Therefore the only value relevant to the intermediate layer having a specific gravity less than 1.2 is the value 0.95. The JIS-C hardness from 85 to 89.9 of the intermediate layer is not enabling. Applicant discloses a Shore D hardness of at least 60, which converts to approximately 90 on the JIS-C scale.

Claim 6 - the difference of 0.1 to 0.5 between the core and the intermediate layer specific gravity is not enabling. Again values within the claimed range have been shown but the entire range is not enabling.

Claims 1 and 3-8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Higuchi (EP 633043A). Regarding claim 1, Higuchi discloses a three-piece solid golf ball comprising a center core, an intermediate layer, and a cover enclosing the core through the intermediate layer (see Higuchi claim 1, page 7). The center core has a diameter of at least 29 mm and a specific gravity of less than 1.4 (see Higuchi claim 1). The intermediate layer is formed from an ionomer base composition (see Higuchi claim 2). The intermediate layer has a thickness of at least 1 mm, a specific gravity less than 1.2, and a hardness of at least 85 on the JIS-C scale (see Higuchi claim 1). The specific gravity of the intermediate layer is lower than the specific gravity of the center core (see Higuchi claim 1). The cover has a thickness from 1 to 3 mm (see Higuchi claim 1). The cover has a JIS-C hardness from 50 to 85, which is softer (lower) than the hardness of the intermediate layer's 85 or more JIS-C hardness (Higuchi page 3, lines 40-41, 49-50). Regarding claim 3, Higuchi discloses a cover hardness from 50 to 85 (page 3, lines 49-50). Regarding claim 4, Higuchi discloses the center core is made from a polybutadiene base rubber composition (see Higuchi claim 4). Regarding claim 5, the center core has a diameter from 29 to 37 (page 3, line 8). Regarding claim 6, the difference in the specific gravity between the center core and the intermediate layer is from 0.1 to 0.5 (page 3, lines 38-39). Regarding claim 7, the specific gravity of the intermediate layer from 0.9 to 1 (page 3, lines 30-31). Regarding claim 8, the JIS-C hardness of the intermediate layer is from 85 to 100 (page 3, lines 30-33).

(11) Response to Argument

Appellant argues the objection to the specification and the declaration is improper. The specification and declaration are objected because appellant continues to disclose the instant application as a Divisional application. While the present specification fully supports the original filed claims the parent application which appellant seeks to claim priority does not support the claims of the present application. In order for appellant to claim priority as a Divisional application the disclosures of the present and parent applications must be identical. In the instant case appellant includes subject matter in the claims that is not present in the parent specification (see details below). Therefore the present application must be a continuation-in-part and not a divisional.

In regard to the 35 USC 112, first paragraph rejection appellant argues the rejection is improper. The Examiner disagrees. Claim 1 - the core with a specific gravity less than 1.4 is non-enabling. Applicant discloses a specific gravity of 1.47 and 1.17, one of which is over the 1.4 limitation. The remaining values in the range are non-enabling subject matter. The limitation requires the specific gravity to be less than 1.4 or from 0 to 1.4. The specific gravity of the intermediate layer is not enabling. The claim requires the intermediate layer to be less than 1.2. Applicant discloses values of 1.3, 0.95, 0.953, and 0.960 for the specific gravity being less than 1.2. Obviously 1.3 is outside the range in question. The values 0.953 and 0.960 cited on page 24 of the specification are specific gravity values for the base ionomer and not the actual composition of the intermediate layer. Therefore the only value relevant to the intermediate layer having a specific gravity less than 1.2 is the value 0.95. The JIS-C

hardness from 85 to 89.9 of the intermediate layer is not enabling. Applicant discloses a Shore D hardness of at least 60, which converts to approximately 90 on the JIS-C scale. Claim 6 - the difference of 0.1 to 0.5 between the core and the intermediate layer specific gravity is not enabling. Again values within the claimed range have been shown but the entire range is not enabling. MPEP 2164.04, pgs. 2100-178 and 2100-179 stating: "(examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure)." The sections also add:

The language should focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims. (emphasis added)

MPEP 2164.04 makes clear that the claims of the application should be rejected under 35 USC 112, 1st paragraph as containing subject matter which was not described in the specification to enable one of ordinary skill in the art to make and/or use the invention as claimed. As shown above the Examiner has satisfied the rejection under 35 USC 112, 1st paragraph by specifically noting portions of the specification where the scope of enablement is not commensurate with that being sought by the instant claims.

In regards to the 35 USC 102(b) over Higuchi, the rejection is proper. As shown in the rejection above Higuchi discloses each and every limitation claimed by appellant. The claimed subject matter in the instant application cannot benefit from the filing date of the parent application because the parent specification does not support the instant claims. Since the claims are supported by the present specification applicant is entitled

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to a priority date of 9-10-97, the date the present application was filed. The Higuchi reference has a priority date of 1-11-95, which is valid prior art under 35 USC 102(b). Higuchi clearly anticipates appellant's claims (pages 3 and 7 of Higuchi).

In conclusion, it is submitted that appellant's claimed subject matter is not supported by the disclosure of the parent application for the reasons set forth above. Therefore, appellant must change the application to a continuation-in-part and receive the priority date of 9-10-97.

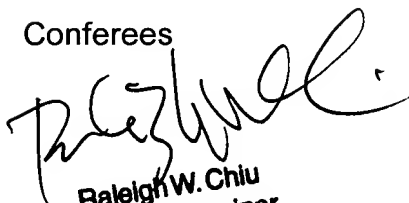
For the above reasons, it is believed that the rejections should be sustained.

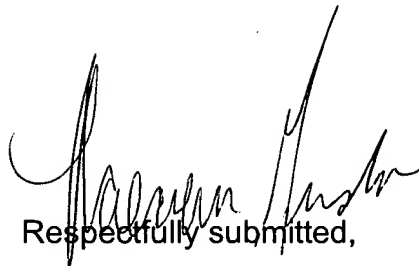
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October 24, 2003

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